

ABsp is patentable without the details of Bsp. The inventions are not distinct and a requirement for restriction must not be made or maintained, even if the subcombination has separate utility." See MPEP Eighth Edition, Revised August 2007, § 806.05(c), "*Criteria of Distinctness Between Combination and Subcombination.*" Here, combination claim 3 requires the details of a biologically active peptide, *as separately claimed* in subcombination claim 1 or 2, *and* a pharmaceutically acceptable carrier. A pharmaceutically acceptable carrier is not separately claimed and cannot be considered as a subcombination claim. Accordingly, combination claim 3 is not patentable without the details of subcombination claim 1 or 2. Applicants therefore respectfully assert that the inventions of Groups I, II, and III are not distinct and restriction requirement for these Groups is improper.

Further, Groups I-VI are directed to 1) a method of making a parathyroid hormone (PTH) analog or 2) a method for treating mammalian condition, for determining rates of bone reformation/resorption/remodeling, or for increasing cAMP in a mammalian cell having PTH-1 receptors, comprising administering to a subject or contacting the cell an effective amount of such PTH analog. Thus, the common subject matter among these Groups is a biologically active PTH analog, and each of the groups is related. Searching and examining this subject matter in these Groups would not be a serious burden on the Examiner. For example, a search for publications pertinent to a PTH analog containing selective amino acid substitutions as claimed in Group I (an analog with 34 amino acid residues) would lead to publications for the shorter version of the PTH analog of Group I in Group II (an analog with 14 amino acid residues). Similarly, a search for publications pertinent to Groups I and II is likely to be

coextensive for a search for methods of treatment, determining rate of bone reformation/resorption/remodeling, or increasing cAMP by using such PTH analog and method of making a PTH analog in Groups III-VI.

At pages 3-4 of the Office Action, the Examiner has also required an election of species if Group I is chosen. Applicants hereby provisionally elect to prosecute the following species:

(a)

X₀₁ ValX₀₂ GluIleX₀₃ LeuMetHisX₀₄X₀₅X₀₆LysX₀₇LeuAsnSerMetGluArgValGluTrpLeu
ArgLysLysLeuGlnAspValHisAsnTyr-NH₂ (SEQ. ID. NO. 31) (claim 1 is readable thereon);

(b) type I osteoporosis (claims 5 and 7 are readable thereon); and

(c) parenteral administration (claim 9 is readable thereon).

These elections are made without prejudice to or disclaimer of the other claims or inventions disclosed.

This election is made **with traverse**.

Applicants submit that to search and to examine the subject matter of these species together would not be a serious burden on the Examiner. Search for publications for a PTH analog would lead to publications for its fragments, pharmaceutically acceptable salts, or N- or C-derivatives. Similarly, search for publications for one type of conditions (i.e. type I osteoporosis) and one route of administration would lead to

publications for other types of conditions (i.e. type II osteoporosis) or other routes of administration.

Finally, in accordance with 37 C.F.R. § 1.141(a), Applicants also reserve the right to claim additional species, and/or to have additional species searched and/or examined, in the event that a generic claim is found to be allowable.

Accordingly, reconsideration and withdrawal of the Restriction Requirement and Species Election, and consideration and allowance of all pending claims, are respectfully requested.

It is not believed that extensions of time are required, beyond those that may otherwise be provided for in accompanying documents. However, if additional extensions of time are necessary to prevent abandonment of this application, then such extensions of time are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required therefor are hereby authorized to be charged to our Deposit Account No. 19-0036.

Respectfully submitted,

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Date: December 10, 2007

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